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09/928,376	08/13/2001	Joe L. Hurst	KG-1807	6299

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EXAMINER

TOLAN, EDWARD THOMAS

ART UNIT

PAPER NUMBER

3725

DATE MAILED: 04/17/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/928,376 Examiner Ed Tolan	Hurst et al Group Art Unit 3725

*OK*

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- Responsive to communication(s) filed on 2-28-03.
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

**Disposition of Claims**

- Claim(s) 1-38 is/are pending in the application.
- Of the above claim(s) 1-21, 28-30 and 33-38 is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 22-27, 31 and 32 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

**Attachment(s)**

- Information Disclosure Statement(s), PTO-1449, Paper No(s). 2  Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

**Office Action Summary**

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**DETAILED ACTION**

***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-21, drawn to a clamping jaw and insert, classified in class 470, subclass 195.
  - II. Claims 22-27,31 and 32, drawn to a nail cutter, classified in class 30, subclass 278.
  - III. Claims 28-30, drawn to a nail, classified in class 411, subclass 439.
  - IV. Claims 33-38, drawn to a nail die assembly having clamping jaws and a cutter nail, classified in class 30, subclass 278.
2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions, group I claims are for clamping and group II claims are for cutting.
3. Inventions I and III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and

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materially different apparatus (MPEP § 806.05(g)). In this case the product can be made by another and materially different apparatus such as by machining or rolling.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require a nail cutting means. The subcombination has separate utility such as a nail cutter.

3. Inventions II and III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the product can be made by another and materially different apparatus such as by machining or rolling.

4. Inventions II and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as

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claimed because the combination does not require clamping jaws. The subcombination has separate utility such as a nail cutter that holds a nail with clamping jaws.

5. Inventions IV and III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the product as claimed can be made by another and materially different apparatus such as by machining or rolling.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

#### *Response to Arguments*

Applicant's arguments with respect to the combination/subcombination restriction of groups I and II are accepted. Applicant's arguments have stated that the inventions are unrelated and not capable of use together so that is reflected in the current restriction. **Applicant's election of group II claims is accepted and an Office Action on those claims follows.**

Regarding Applicant's assertion that a nail rolling machine is not recognized, the restriction has been modified to include machining (milling, lathing etc). Nails can certainly be produced individually on a machining station. In regard to rolling, rods, wires etc. are deformed by rolling machines to form nail like products, spikes, pins etc. The term "nail" was being

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broadly read by the Examiner, since Applicant did not recognize this fact the term “machining” has been added as an alternative apparatus. In an event, the Examiner has included a “nail rolling machine” (GB 2034223).

***Drawings***

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the cutting insert (24) described on page 11, line 23 must be shown in figure 9 or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 31 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has set forth an acute angle of 90-150 degrees. Acute angles in

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geometry are known as angles less than 90 degrees. In the specification page 11, line 29,

Applicant has described an “included angle” of 90-150 degrees.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 22-25,31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werner (2,178,711) in view of Schretter et al. (5,979,216). Werner discloses a die holding body (10) and a die insert (35). The holding body has a pentagonal pocket formed by the holding body sides (21,21a) which form acute locating angles with respect to the holding body centerline and the sides (19). Werner does not disclose that the die insert is a nail cutter, Werner sets forth that the die is for nail forming. Schretter teaches that it is known to provide a cutting insert (9) that includes a nail cutter (10). The cutting insert is a variant of nail forming insert (2). It would have been obvious to one skilled in the art at the time of invention to provide the die insert of Werner with a cutting surface as taught by Schretter in order to cut a nail shank.

10. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werner in view of Schretter and further in view of Andersson (6,196,771). Werner in view of Schretter does not disclose that the acute locating angle is rounded. Andersson (figure 8) teaches that cutting insert (11) is seated in body (30) that has rounded pockets edges. It would have been obvious to one skilled in the art at the time of invention to round the pocket angles of Werner in

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view of Schretter as taught by Andersson in order to easily seat the insert corners. Regarding claim 27, the provision of a more or less rounded pocket angle is an obvious variant of the teaching of Andersson.

11.

*Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
13. Any inquiry concerning this communication should be directed to Ed Tolan whose telephone number is 703-305-3021.

ETT 4-9-03

ED TOLAN  
PRIMARY EXAMINER  
